

REMARKS

Applicants request reconsideration of the above-identified application in view of the foregoing proposed amendments and the following remarks.

Applicants have amended claims 11, 16, 22, 27, 42, 45 and 47.

Applicants have added new claims 51-63. New claims 51-63 were first presented in a Preliminary Amendment, filed on March 24, 2005, in U.S. Application No. 11/090,570, which is a continuation of this application. Claims 51-63 were presented to “copy” pending claims from Elder et al. U.S. Patent Application No. 10/247,504 (“the Elder ‘504 application”), to comply with 35 U.S.C. § 135(b) and to provoke an interference with the Elder ‘504 application.

As a result of this amendment, the claims pending in this application are claims 1-63.

This application claims priority from U.S. Provisional Application Serial No. 60/412,307, filed September 20, 2002; U.S. Provisional Application Serial No. 60/421,432, filed October 25, 2002; and U.S. Provisional Application Serial No. 60/431,147, filed December 5, 2002. Thus, Applicants are entitled to a filing date of September 20, 2002.

I. INTRODUCTION

The purpose of this Amendment is to respond to the Final Rejection dated February 23, 2005, and together with the accompanying Suggestion of Interference with Elder et al. Application No. 10/247,504, Pursuant to 37 C.F.R. § 41.202, and supporting

declarations and exhibits, to provoke an interference with Elder et al. U.S. Patent Application No. 10/247,504 ("the Elder '504 application").

The outstanding rejections are (1) a 35 U.S.C. § 112, second paragraph rejection of claims 11-32 and 45-56; (2) a 35 U.S.C. § 103(a) rejection of claims 1-50 over the published Elder '504 application; and (3) five provisional obviousness-type double patenting rejections over commonly assigned applications.

As explained below (pages 13-15), Applicants have amended independent claims 11, 16, 22, 27, 45 and 47 to overcome the 35 U.S.C. § 112, second paragraph rejection and are submitting respective terminal disclaimers to overcome each of the obviousness-type double patenting rejections by disclaiming, as to each of the respective commonly assigned applications, the terminal part of the term of any patent issued on whichever of this application and the respective one of the commonly-assigned applications first issues as a patent, and requiring maintenance of common ownership between any patent issued on this application and any patent issued on the respective commonly-assigned application.

Applicants have amended claim 42 from 75 ppb acrylamide to 100 ppb acrylamide to conform the claim to the disclosure of the parent provisional applications.

Thus, the only remaining rejection is the obviousness rejection under 35 U.S.C. § 103 over the published Elder '504 application, that is based on an application having a filing date only one day before Applicants' earliest effective filing date of September 20, 2002. For reasons previously stated, Applicants do not agree with the basis for the Examiner's rejection of claims 1-50 over the published Elder '504 application. However, to overcome the rejection, Applicants now seek the declaration of an interference between claims 1-63 of this application and pending and allowable claims

1-8 and 11-15 of the Elder '504 application (pages 15-16). Pursuant to 37 C.F.R. § 41.202, Applicants are submitting herewith a Suggestion of Interference with Elder et al. Application No. 10/247,504, Pursuant to 37 C.F.R. § 41.202, together with the declarations of Dr. David Vincent Zyzak, Dr. Kwan Y. Lee, Deborah K. Ewald and Janice N. Batchelor, and supporting exhibits. This Suggestion of Interference seeks the declaration of an interference with the Elder '504 application and demonstrates why Applicants would prevail on priority versus the Elder '504 application.

II. NEW CLAIMS 51-63

As noted above, new claims 51-63 were first presented in a Preliminary Amendment, filed on March 24, 2005, in Application No. 11/090,570, which is a continuation of this application.

New claims 51-63 were presented in order to "copy" pending and allowable claims 1-8 and 11-15 of the Elder '504 application in order to comply with 35 U.S.C. § 135(b), and to provoke an interference with the Elder '504 application. Applicants have elected to pursue those claims in this application and to provoke an interference involving claims 1-63 of this application and claims 1-8 and 11-15 of the Elder '504 application.

Applicants' new claims 51-63 relate to a method for reducing the amount of acrylamide in thermally processed foods and foods produced by such a method. More specifically, Applicants' claims 51-63 relate to a method for reducing the amount of acrylamide in thermally processed foods by adding an asparaginase solution to inactivate asparagine in an asparagine-containing food material, using said food material as a

component in a food mixture, and heating the mixture to form a thermally processed food product.

The March 24, 2005, Preliminary Amendment submitted in Application No. 11/090,570 (pages 9-12), demonstrated that new claims 52-63 are fully supported by Applicants' specification. This table is reproduced as Appendix A to the accompanying Suggestion of Interference.

III. RESPONSE TO 35 U.S.C. § 112 REJECTION

Claims 11-32 and 45-50 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.*

The Examiner states that the term "reduced" in Claims 11-32 and 45-50 is indefinite. The Examiner further states that the term "reduced" "is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention." (Office action, p. 2).

While Applicants respectfully disagree with the Examiner's assertions, Applicants have amended independent claims 11, 16, 22, 27, 45 and 47 to obviate the rejection of claims 11-32 and 45-50.

Applicants have amended claims 11, 16, 22, 27, 45 and 47 to provide that the level of asparagine or acrylamide in the food material (or food product) is reduced

* Applicants note that the Examiner has withdrawn the 35 U.S.C. § 112, second paragraph rejections of Claims 1-5 and 7-10, and of Claims 46 and 48.

from the level of asparagine or acrylamide present in the food material (or food product) in a previous condition.

Applicants respectfully request reconsideration and allowance of Claims 11-32 and 45-50 over the Examiner's 35 U.S.C. § 112, second paragraph, rejection.

IV. RESPONSE TO THE NON-STATUTORY DOUBLE PATENTING REJECTIONS

The Examiner has made five provisional obviousness-type double patenting rejections of various subsets of pending claims 1-50 over five commonly-assigned applications as follows:

1. Claims 45-50 over claims 5-12 of Application No. 10/606,260;
2. Claims 1-32 and 42-50 over claims 1-44 of Application No. 10/603,279;
3. Claims 11-44 and 47-50 over claims 1-12 of Application No. 10/603,978;
4. Claims 1-20, 22-31 and 45-50 over claims 1-57 of Application No. 10/603,973; and
5. Claims 1-26, 22-31 and 45-50 over claims 1 and 3-18 of Application No. 10/603,278.

Accompanying this amendment are five terminal disclaimers that obviate these provisional obviousness-type double patenting rejections by respectively disclaiming, as to each of the respective commonly assigned applications, the terminal part of the term of any patent issued on whichever of this application and that respective one of the commonly-assigned applications first issues as a patent, and requiring

maintenance of common ownership between any patent issued on this application and any patent issued on that respective commonly-assigned application.

The Director is hereby authorized to charge \$130.00, in payment of the fee set forth in 37 C.F.R. § 1.20(d) and any additional fee that may be due, in connection with each terminal disclaimer, to Deposit Account No. 06-1075, as set forth on the accompanying Fee Transmittal form.

V. RESPONSE TO 35 U.S.C. § 103 REJECTION

Claims 1-50 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Elder et al. (U.S. Patent publication No. US 2004/0058054). That publication is based on Elder et al. U.S. Patent Application No. 10/247,504 (“the Elder ’504 application”), filed on September 19, 2002.

The Examiner states that the Elder ’504 application “discloses a method for reducing the amount of acrylamide in thermally processed foods,” “states that the thermally proceed foodstuffs which originally contained asparagine tested positive for acrylamide,” and “states that ‘one such method for inactivating [asparagine] is to contact asparagine with the enzyme asparaginase’” (Office action, p. 4).

The Examiner also states that the Elder ’504 application “clearly and unambiguously suggests to one of ordinary skill in the art, the instantly-claimed method of utilizing an asparaginase enzyme for inactivating asparagine in a food material, including potato products, thereby reducing the level of acrylamide which would be formed in the subsequently heated food material.” (Office action, p. 6).

While Applicants do not agree with the Examiner’s statements concerning the disclosure of the Elder ’504 application, Applicants now seek the declaration of an

interference between claims 1-63 of this application and pending and allowable claims 1-8 and 11-15 of the Elder '504 application.

The Elder '504 application has a filing date of September 19, 2002, or just one day before Applicants' earliest effective filing date of September 20, 2002.

Pursuant to 37 C.F.R. § 41.202, Applicants are submitting herewith a Suggestion of Interference with Elder et al. Application No. 10/247,504, Pursuant to 37 C.F.R. § 41.202, which seeks the declaration of an interference and, along with the accompanying declarations and exhibits, demonstrates why Applicants would prevail on priority versus the Elder '504 application.

Applicants respectfully submit that based on the foregoing amendments and remarks and the accompanying Suggestion of Interference, declarations and exhibits, an interference should be declared between claims 1-63 of this application and pending and allowable claims 1-8 and 11-15 of the Elder '504 application.

VI. CONCLUSION

Applicants respectfully submit that claims 1-63 are otherwise allowable and an interference should be declared between claims 1-63 of this application and

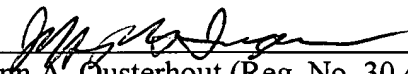
Appl. No. 10/606,137
Amdt. Dated August 22, 2005

pending claims 1-8 and 11-15 of Elder et al. U.S. patent Application No. 10/247,504.

Applicants are herewith submitting a Suggestion Of Interference with Elder et al.

Application No. 10/247,504, Pursuant to 37 C.F.R. § 41.202, together with four
declarations and supporting exhibits.

Respectfully submitted,



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